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EXAMINER

BARRETT, SUZANNE LALE DINO

ART UNIT PAPER NUMBER

3676

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/789,630

Applicant(s)

TREMPALA, DOHN J.

Examiner

Suzanne Dino Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 24-38 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 31 is/are allowed.
- 6) ☒ Claim(s) 1-7, 24-30, 32, 33, 36, 38 is/are rejected.
- 7) ☒ Claim(s) 34, 35 and 37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/15/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 33 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 33, it is unclear whether Applicant intends to claim the combination of a locking cap and fire department connection or the subcombination locking cap alone. While the preamble sets forth the subcombination locking cap alone, with the intended use on a fire department connection, the body of the claim later recites "sized and configured to be received by...fire department connection" which would lead one to infer that the combination is intended to be claimed. Since the claim is unclear as it is, if Applicant intends to claim the combination, the combination must be positively claimed.

Claim Objections

3. Claim 28 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 28 recites locking

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cap limitations which do not further limit the key of claims 24 and 27 from which it depends.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-4,32,36,38 are rejected under 35 U.S.C. 102(b) as being anticipated by Hoshino 5,419,650. Hoshino teaches a plug 21 and face plate 32 cap expander assembly for a pipe end 50 comprising a threaded actuator 70, having a configured head with a conventional female slot to receive a conventional male tool member, and attached to a tapered spreader member 41 which expands the plug member 21 into frictional engagement with the pipe walls 50 when locked. The plug comprises a front surface (at 51a (bottom) in Fig.3), rear surface (at 21a (top) in Fig.2), side outer surface (at 21a in Fig.1) and a slot 22 (fig.1) extending longitudinally between the front and rear and radially between the side and a relief opening (the top plane of slot 22 corresponding to the thickness of the wall of plug member 21, i.e. the entrance of the open-ended slot) and further, wherein the inside of the plug forms a channel therethrough (coextensive with the surface 23,24,25 defining the perimeter of the inside wall of plug 21 in Fig.1) and radially displaced from the relief opening (top plane of slot 22), which receives a spreader member 41 and the actuator 70. With respect to new

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claim 32, the channel coextensive with surface 23 in Fig. 1 is considered "radially displaced" from the relief opening which is interpreted as the top plane portion of slot 22 corresponding to the thickness of the outer side wall of plug 21.

6. Claims 24-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Strauch 5,704,261. Strauch et al teach a key/tool member 3 comprising a head 2 having a raised portion on the distal tip thereof to engage a structure, a handle shaft 3,4, defining a deformation zone without a relief cut which, upon torquing of the tool beyond a predetermined amount, deforms plastically (col. 4, lines 10-24; claims 10,12). It would have been obvious to one of ordinary skill in the art to utilize such a tool/key as taught by Strauch et al, on a locking cap actuator such as that previously discussed with respect to Hoshino. It is noted that the preamble recitation of a "locking cap" key does not impart structure to the key and is considered intended use of the key and not accorded patentable weight. Furthermore, the limitation of claim 28 does not further limit the key structure and is not accorded patentable weight.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 7 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshino 5,419,650 in view of Borenstein 4,651,771.

With respect to claim 7, Hoshino teaches a plug member on a locking cap but fails to specify the material used. Borenstein et al teach, in col. 4, line 65, the use of brass among other suitable materials for a plug lock member. It would have been obvious to one of ordinary skill in the art to modify the material of Hoshino by providing brass as taught by Borenstein et al as an obvious matter of design choice.

With respect to claim 33, Hoshino teaches the pipe lock cap expander arrangement described above but fails to teach the use of such an expander cap in combination with a fire department connection. Borenstein teaches a fire department connection in a fire hydrant having a pipe 18 with a locking cap 28 therefor having a female patterned pentagonal head 46 which is engaged by a correspondingly patterned tool head 50 to remove the locking cap from the pipe 18. It would have been obvious to one of ordinary skill in the art to combine the teachings of Hoshino and Borenstein by providing a locking cap with the pipe cap expander arrangement taught by Hoshino on a fire department connection pipe taught by Borenstein as an obvious matter of design choice in substituting one type of pipe cap for another.

9. Claims 5,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshino '650 in view of Lanham 6,017,177. Lanham teaches the use of a bolt head 30/35 (Fig. 1) having a female cloverleaf pattern consisting of seven apexes (35) and eight wavy grooves connecting the apexes, actuated by a similarly configured key head 20/25. It would have been obvious to one of ordinary skill in the art to modify the female pattern bolt head 22 of Hoshino by providing a cloverleaf configured bolt head and accompanying key head as taught by Lanham to enhance the security of the lock.

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10. Claims 24,29 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Stehling '501 in view of Strauch et al '261. Stehling teaches a key member having a hole portion (at 40) which is capable of receiving a key ring. It would have been obvious to one of ordinary skill in the art to modify the key of Stehling by providing a deformation zone as taught by Strauch et al as an obvious matter of design choice in enhancing the security of the lock cap.

11. Claims 24,30 are further rejected under 35 U.S.C. 103(a) as being unpatentable over Borenstein '771 in view of Patterson '831. Borenstein et al teach a key member comprising a T-shaped cross member configuration at one end (49/66) with a hole 66 disposed in one cross member. It would have been obvious to one of ordinary skill in the art to modify the key of Borenstein et al by providing a deformation zone as taught by Strauch et al as an obvious matter of design choice in enhancing the security of the lock cap.

Allowable Subject Matter

12. Claim 31 is allowed.

The limitation in claim 31 requiring the channel to be disposed between the slot side surface and the relief opening defines over Hoshino which clearly teaches the channel (portion coextensive with surface 23 in Fig.1) radially disposed after the slot 22 and relief opening (top plane of slot 22).

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13. Claims 34,35,37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The channel of Hoshino intersects the entire slot and not just a portion of the slot as set forth in claim 34. The slot of Hoshino does not extend through "two sides" of the channel as set forth in claim 35 and further, does not teach that the face plate and plug are secured by fasteners (plural), since Hoshino teaches that they are secured only by the fastener 70.

Response to Arguments

14. Applicant's arguments filed 9/15/06 have been fully considered but they are not persuasive. As set forth above, the previous rejections and objections have been maintained.

Regarding the rejection of claim 33 under 35 U.S.C. 112, the Examiner respectfully disagrees with Applicant's arguments. The very fact that Applicant argues both the combination (Remarks, pages 7, lines 16-24) and the subcombination (page 7, last line-page 8, lines 1-5) is evidence of the ambiguity with respect to the scope of the claim. Accordingly, this rejection is maintained.

Regarding the objection to claim 28 under 37 CFR 1.75 (C), the Examiner respectfully disagrees with Applicant's arguments. The amendment to claim 28 does not obviate this objection. The scope of the claim with respect to the claimed key cannot be

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ascertained since the key structure is dependent on structure (the cap recessed pattern) which is not positively claimed. Accordingly, this objection still stands.

Regarding the prior art rejections, with respect to applicant's arguments against Hoshino presented on page 9 of the remarks, the examiner respectfully disagrees. It is maintained that the relief opening is co-extensive with the top surface of the plug and therefore within the plug structure. Furthermore, it is also maintained that the slot 22 does extend radially between the side surface (21a in Fig.1) and a portion of the relief opening, regardless of the fact that the two surfaces extend normal to each other at the top.

With regard to Applicant's arguments against Strauch, it is maintained that a screwdriver bit is considered a "key" type tool and therefor anticipates the claimed structure.

Regarding Borenstein, it is maintained that the combination with Hoshino is proper since the intended use of the device on a fire dept connection would have been obvious to one of ordinary skill in the art.

With respect to Stehling and Strauch, it is maintained that one of ordinary skill in the tool art would have looked to other torque tools to provide a torque limiting means as needed for the desired function.

Further, Lanham clearly teaches enhancing security by providing various key patterns.

Accordingly, Applicant's arguments are not persuasive and the rejections stand.

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 571-272-7053. The examiner can normally be reached on M-Th 8:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Suzanne Dino Barrett
Primary Examiner
Art Unit 3676

sdb